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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/450,437 05/25/95 FARINA

C P30958C2

12M1/1104

EXAMINER

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ART UNIT

PAPER NUMBER

10

1207

DATE MAILED:

11/04/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 6-18-97

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-8, 11, 14-25 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-8, 11, 14-25 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

Art Unit 1207

Applicants' Abstract is now longer than 25 lines.

Correction is required.

Claims 1-8, 11, 14, 15 and 17-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

It is not clear if the material in parentheses is meant to be examples or definitions. For example in claim 15 the phrase "food intake inhibition" in the phrase "eating disorders (food intake inhibition)" define the term "eating disorder" or is it merely an example of an eating disorder? The term "for example" similarly renders those claims in which this term appears. It is not clear whether claims reciting the term "example" or using parentheses are limited to the examples or are merely limited by the broader term to which the examples pertain.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Art Unit 1207

Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Shah (USP 5,434,158).

Shah discloses a process in which an NK3 receptor antagonist (column 3 lines 54-56) is used to treat diseases such as alzheimer's (column 16 lines 32 et seq.).

Claim 16 is rejected under 35 U.S.C. 102(e) as being anticipated by Chiang et al. (USP 5,607,936).

Chiang et al. disclose treatment of psoriasis, etc. using NK3 receptor antagonists (column 18 lines 33 et seq.).

Applicants' arguments filed 6-18-97 have been fully considered but they are not deemed to be persuasive.

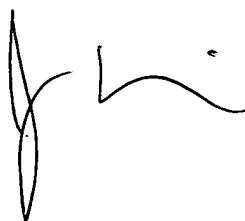
Applicants state that it is clear to applicants that the material in parentheses is meant to be examples. However it is not clear how those skilled in the art would know this by reading applicants' claims and in any case examples render claims unclear in that the claim can be construed as being limited to the examples or merely being limited by the broader term to which the examples pertain.

This action is not being made final.

Any inquiry concerning this communication should be directed to Jeffrey Mullis at telephone number (703) 308-2820.

J. Mullis:cdc

October 14, 1997



JEFFREY C. MULLIS  
PRIMARY EXAMINER  
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